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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,204	12/12/2003	Mark Jenkin	2100.005000/JENKIN-1	1798
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WILLIAMS, MORGAN & AMERSON 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			EXAMINER AHMED, AFFAF	
			ART UNIT	PAPER NUMBER
			3622	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,204	Applicant(s) JENKIN, MARK	
	Examiner Affaf Ahmed	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 12/12/2003.
2. Claims 1-15 are currently pending and have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claimed invention must fall into one of the four recognized statutory classes of invention, a process (or method), a machine (or system); an article of manufacture; or a composite of matter. However claim 12 does not seem to fall within one of these recognized categories. The invention seems to be directed toward an article of manufacture, however, computer program mechanism claimed as embodied in computer readable media is descriptive material per se and is not statutory because it is not capable of causing functional change in the computer. Such claimed computer programs do not define any structural and functional interrelationships between the computer code and other claimed elements of a computer, which permit the computer's program to be realized (see MPEP section 2106). Simply stated invention not claimed, as computer program that when executed by the computer causes the computer to perform the claimed limitation is not statutory. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1- 15 are rejected under 35 U.S.C. 102 (b) as being anticipated by Stanbach et al, US Pat No: 6,449,657.

As per **claims 1, 12 and 13**, Stanbach teaches:

- *receiving a text message having an unused region (see at least column 9, 59-62);*
- *inserting information into the unused region; and*
- *forwarding the text message to an intended recipient.*

See at least column 10, lines 5-9 and fig 8 with associated text.

As per **claim 2**, Stanbach teaches:

- *wherein inserting information into the unused region further comprises inserting an advertisement into the unused region (see at least column 10, lines 5-9).*

As per **claims 3 and 5**, Stanbach teaches:

- *selecting at least one of the plurality of advertisements based upon content of the text message*
- *selecting at least one of a plurality of advertisements based upon information associated with the text message.*

See at least column 13, lines 38-42.

As per **claim 4**, Stanbach teaches

- *selecting at least one of the plurality of advertisements based upon a time at which the text message was sent (see at least column 13, lines 63-67 and column 14, lines 1-4)*

As per **Claims 6 and 7**, Stanbach teaches:

- *selecting at least one of a plurality of advertisements based upon information associated with a sender of the text message.*

- *selecting at least one of the plurality of advertisements based upon personal information associated with the sender of the text message.*

See at least column 15, lines 22-26.

As per **claims 9 and 10**, Stanbach teaches:

- *selecting at least one of a plurality of advertisements based upon information associated with the intended recipient of the text message.*
- *selecting at least one of the plurality of advertisements based upon personal information associated with the intended recipient of the text message.*

See at least column 9, lines 62-66.

As per **claims 8 and 11**, Stanbach teaches:

- *selecting at least one of the plurality of advertisements based upon a location of the intended recipient of the text message.*
- *selecting at least one of the plurality of advertisements based upon a location of the sender of the text message.*

See at least column 15, lines 3-5.

As per **claim 14**, Stanbach teaches:

- *receiving a text message comprising an embedded advertisement (see at least column 9, lines 59-66 and column 10, lines 1-5).*

As per **claim 15**, Stanbach teaches:

- *transmitting a text message comprising an embedded advertisement (see at least column 10, lines 5-9).*

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Monceriff, US Pat No: 5,828,839, teaches computer network chat room based on channel broadcast in real time.
 - Takakura et al, US Pub No: 2003/0195801, teaches system and method for providing advertisement with conversation data to users.
 - Aufricht et al, US Pub No: 2002/0052781, teaches interactive advertisement mechanism on a mobile device.
 - Kaneko et al, US Pub No: 2002/0107737, teaches data providing system, data providing apparatus and method, data acquisition system and method, and program storage medium.
 - Vésikivi, EP 127908 A2, teaches a system and method for person to person messaging with a value added service.
 - Kanerva, WO 2002/054803, teaches processing messages in communication system.
 - McGregor, US Pub 2002/0026360, teaches system for generating revenue using electronic mail and method for its use.
 - Ford et al, US Pat No: 6,606,644, teaches system and technique for dynamic information gathering and targeted.
 - Baracco, WO: 03/088690, teaches method for changing the content of a message exchanged between two telephones.
 - Chern et al, US Pat No: 6,381,465, teaches system and method for attaching an advertisement to an SMS message for wireless transmission.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at


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866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RA


RETTA YEHDEGA
PRIMARY EXAMINER